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Docket No. 18-859-0 PCT

PATENT, TRADEMARK AND COPYRIGHT LAW
AND RELATED FEDERAL AND ITC LITIGATION

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HON. COMMISSIONER OF PATENTS AND TRADEMARKS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 08/295,782
Applicant(s): Hitoshi NISHIYAMA, et al.
Filed: September 12, 1994
For: DEPSIPEPTIDE DERIVATIVE, PRODUCTION
THEREOF AND USE THEREOF

ATTN: APPLICATION PROCESSING DIVISION, SPECIAL
PROCESSING AND CORRESPONDENCE BRANCH

SIR:

Attached hereto for filing are the following papers:

**RESPONSE TO NOTICE TO COMPLY...ACID SEQUENCE DISCLOSURES
CITED REFERENCE (1)
NOTICE TO FILE MISSING PARTS
NOTICE TO COMPLY**

Our check in the amount of \$ -0- is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
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08/295,782 09/12/94 NISHIYAMA H 18645901-01

03B1/0113

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ARLINGTON VA 22202

DATE MAILED: 0000

**NOTICE TO FILE MISSING PARTS OF APPLICATION
FILING DATE GRANTED**

01/10/95

An Application Number and Filing Date have been assigned to this application. However, the items indicated below are missing. The required items and fees identified below must be timely submitted **ALONG WITH THE PAYMENT OF A SURCHARGE** for items 1 and 3-6 only of \$ 50.00 for large entities or \$ _____ for small entities who have filed a verified statement claiming such status. The surcharge is set forth in 37 CFR 1.16(e).

If all required items on this form are filed within the period set below, the total amount owed by applicant as a large entity, small entity (verified statement filed), is \$ 0.

Applicant is given **ONE MONTH FROM THE DATE OF THIS LETTER, OR TWO MONTHS FROM THE FILING DATE** of this application, **WHICHEVER IS LATER**, within which to file all required items and pay any fees required above to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

1. The statutory basic filing fee is: missing insufficient. Applicant as a large entity small entity, must submit \$ _____ to complete the basic filing fee.
2. Additional claim fees of \$ _____ as a large entity, small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.
3. The oath or declaration:
 is missing.
 does not cover items omitted at time of execution.
4. The oath or declaration does not identify the application to which it applies. An oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
5. The signature(s) to the oath or declaration is/are: missing; by a person other than the inventor or a person qualified under 37 CFR 1.42, 1.43, or 1.47. A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
6. The signature of the following joint inventor(s) is missing from the oath or declaration:

_____ An oath or declaration listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

7. The application was filed in a language other than English. Applicant must file a verified English translation of the application and a fee of \$ _____ under 37 CFR 1.17(k), unless this fee has already been paid.
8. A \$ _____ processing fee is required since your check was returned without payment. (37 CFR 1.21(m)).



18-859-0 PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF : :

Hitoshi NISHIYAMA, et al. : ATTN: APPLICATION PROCESSING

SERIAL NO: 08/295,782 : DIVISION, SPECIAL
PROCESSING AND
CORRESPONDENCE BRANCH

FILED: September 12, 1994 :

FOR: DEPSIPEPTIDE DERIVATIVE, PRODUCTION THEREOF AND USE
THEREOF

RESPONSE TO NOTICE TO COMPLY WITH REQUIREMENTS
FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE
SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

HONORABLE COMMISSIONER OF PATENTS & TRADEMARKS
WASHINGTON, D.C. 20231

SIR:

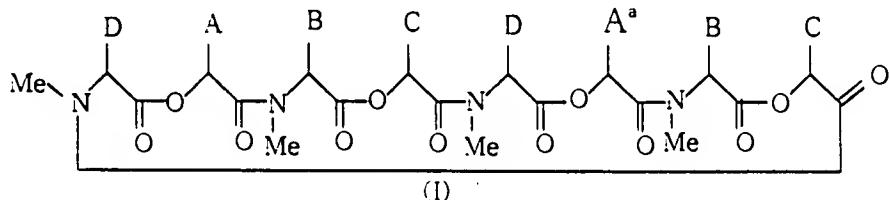
Responsive to the Notice To File Missing Parts and the
Notice To Comply With Requirements for Patent Applications
Containing Nucleotide Sequence and/or Amino Acid Sequence
Disclosures dated January 13, 1995, Applicants submit that a
Sequence Listing is not necessary in the above-identified
application.

REMARKS

According to 37 C.F.R. §§ 1.821-1.825 an amino acid
sequence which must be represented by both a paper and a
computer readable Sequence Listing consists of an unbranched
sequence of four or more amino acids. Amino acids are defined
under 37 C.F.R. § 1.821(a)(2) as L-amino acids. In addition,
any peptide or protein expressible using the symbols contained
in § 1.822(b)(2) in conjunction with a description (i.e., a

feature note) is embraced by the definition of an amino acid sequence. However, Applicants note that the sequences in the above-identified application are not included in the definition of an amino acid sequence given by 37 C.F.R. § 1.821.

The present invention relates to depsipeptide derivatives represented by the following formula (I):



Formula (I) contains alternating amino acid (moieties containing substituents D and B) and lactic acid (moieties containing substituents A, A* and C) groups. The structure of lactic acid is shown by formulas (24) and (25) on page 95 of J. March, ADVANCED ORGANIC CHEMISTRY (1985), attached herewith. Lactic acid is not an amino acid, but rather an α-hydroxy acid, and therefore, can not be represented by any of the three-letter amino acid abbreviations given in 37 C.F.R. § 1.822(b)(2). As a result, the depsipeptide shown by formula (I) does not contain a sequence of four or more amino acids or any peptide or protein that can be expressed as a sequence using the symbols in 37 C.F.R. § 1.822(b)(2).

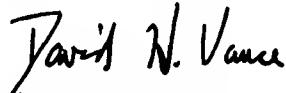
Furthermore, all of the other depsipeptides shown in the text of the above-identified application contain structures similar to that of Formula I, i.e., alternating amino acid and lactic acid. Accordingly, the sequences disclosed in the

above-identified application are not subject to the requirements of 37 C.F.R. §§ 1.821-1.825, and withdrawal of this requirement is respectfully requested.

In view of the foregoing, Applicants submit that the application is now in condition for examination on the merits. Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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